

## REMARKS

Reconsideration of this application is respectfully requested.

Claims 1, 4-10, 13, 14, 16, 19-22 and 24-26 are pending in the application.

Claims 1, 4-10, 13, 14, 16, 19-22 and 24-26 are rejected.

Claims 1, 13, and 24-26 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1, 13, and 14 stand rejected under 35 U.S.C. §102(a) as being anticipated by InfoNet.

Claims 24-26 stand rejected under 35 U.S.C. §102(a) as being anticipated by Pennsylvania Official Transportation and Tourism Map ("Map").

Claims 4, 5, 16, and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of Official Notice of alleged knowledge in the art.

Claims 6-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of InConcert.

Claim 9 stands rejected under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of U.S. patent no. 6,052,684 of Du ("Du").

Claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of Du and further in view of U.S. patent no. 6,243,092 of Okita, et. al ("Okita").

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of U.S. patent no. 5,835,898 of Borg ("Borg").

## CLAIM REJECTIONS

### Rejections under 35 U.S.C. §101

Claims 1, 13, and 24-26 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The preambles of claims 1, 13, and 24-26 have been amended to state "A method...relating to a workflow driven by a computer system...." Applicants respectfully submit that claims 1, 13, and 24-26 are not directed to non-statutory subject matter, under 35 U.S.C. §101.

### Rejections under 35 U.S.C. §102(a)

The Examiner has rejected claims 1, 13, and 14 under 35 U.S.C. §102(a) as being anticipated by InfoNet. Applicants submit that amended claims 1, 13, and 14 are not anticipated by Mattson. In regard to the rejection of claim 1, the Examiner has stated in part that:

“A method of displaying information relating to a workflow comprising the steps of: executing the workflow; gathering statistical information relating to the execution of the workflow; displaying a workflow diagram; and overlaying the gathered information over the workflow diagram, wherein the overlaid information indicates workflow statistics for various steps displayed in the workflow diagram” is disclosed by InfoNet... (11/29/02, Office Action, p. 3)

Applicants respectfully submit that amended claim 1 is not anticipated by InfoNet. Claim 1 recites the feature of “gathering execution statistics relating to the execution of the workflow on the computer system.” (Emphasis added) InfoNet does not disclose this feature as can be seen by the following analysis of InfoNet. “InfoNet is custom software developed by DXP to gather necessary information and to keep everyone, both internally and externally, aware of every project detail.” The necessary information includes “latest company news, messages from coworkers, clients and task information.” Info Net does not contemplate “execution statistics relating to the execution of the workflow on the computer system.”

Because InfoNet does not disclose this feature as taught by claim 1, from which claims 4-8 depend applicants respectfully submit that claims 1 and 4-8 are not anticipated under 35 U.S.C. §102(a) by InfoNet.

The Examiner also rejected independent claim 13 under 35 U.S.C. §102(a) for the reason set forth in the rejection of claim 1. Claim 13 discloses substantially similar limitations as claim 1, and recites “collecting execution statistics relating to the execution of the workflow on the computer system...” (Emphasis added) Because, InfoNet does not disclose this feature as taught by applicant’s claim 13 from which claims 14, 16, and 19-22 depend, for the reasons discussed above with regard to claim 1, applicants respectfully submit that claims 13-14, 16, and 19-22 are not anticipated under 35 U.S.C. §102(a) by InfoNet.

The Examiner also rejected independent claim 7 under 35 U.S.C. §102(a) for the reason set forth in the rejection of claim 1. Claim 7 discloses substantially similar limitations as claim 1, and recites “a cache memory array dynamically partitioned when multiple memory requests are received....” (Emphasis added) Because, Mattson does not disclose this feature as taught by applicants for the reasons discussed above with regard to claim 1, applicants respectfully submit that claim 7 is not anticipated under 35 U.S.C. §102(a) by Mattson.

The Examiner has rejected claims 24-26 under 35 U.S.C. §102(a) as being anticipated by InfoNet. Applicants submit that claims 24-26 are not anticipated by Pennsylvania Tourism Map. In regard to the rejection of claim 24, the Examiner has stated in part that:

A method of collecting...number of steps... and displaying the collected information” is disclosed by Pennsylvania Official Transportation and Tourism Map... (11/29/02, Office Action, p. 7)

Applicants respectfully submit that claim 24 is not anticipated by the Map Amended. claims 24 recites the feature of “collecting execution statistics relating to the execution of the workflow on the computer system...” (Emphasis added) The Map does not disclose this feature, since a map does not permit the execution of the workflow on the computer system. Because the Map does not disclose this feature, as taught by claim 24, applicants respectfully submit that claim 24 is not anticipated under 35 U.S.C. § 102(a) by the Map.

The Examiner also rejected independent claim 25 under 35 U.S.C. §102(a) for the reason set forth in the rejection of claim 24. Claim 25 discloses substantially similar limitations as claim 25, and recites “collecting execution statistics relating to the execution of the workflow on the computer system” (Emphasis added) Because, the Map does not disclose this feature as taught by applicants for the reasons discussed above with regard to claim 24, applicants respectfully submit that claim 25 is not anticipated under 35 U.S.C. §102(a) by the Map.

### Rejections Under 35 U.S.C. §103

The Examiner has rejected claims 4, 5, 16, and 19-21 under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of Official Notice of alleged knowledge in the art.

In regard to the rejection of claim 4 under 35 U.S.C. §103(a), the Examiner has stated in part that:

Per claim 4, "The method of claim 1, wherein the everlayed information indicates the number of times a certain step was executed" is disclosed by Official Notice taken that the art is replete with road maps

(11/29/02 Office Action, p. 8).

As to claim 4, neither a road map such as the Tourism Map, nor InfoNet suggest a combination with each other. Even if InfoNet and the alleged knowledge were combined, such a combination would lack one or more features of claim 1, from which claims 4-8 depend. Amended claim 1 recites the feature of "gathering execution statistics relating to the execution of the workflow on the computer system. (emphasis added)

InfoNet does not disclose this feature as disclosed in applicants' claim 1. InfoNet does not gather execution statistics and instead gathers "nice-to-know" information such as company news, messages from co-workers, etc

Nor does the alleged knowledge of the Map disclose gathering execution statistics relating to the execution of the workflow on the computer system as claimed by applicants. Thus, because neither, InfoNet nor the alleged knowledge in the art disclose applicant's claim 1, applicants respectfully submit that claim 1 is not obvious under 35 U.S.C. §103(a) by InfoNet in view of the alleged knowledge in the art. Given that claims 4-8 depend from claim 1, applicants respectfully submit that claims 1, and 4-8 are not obvious under 35 U.S.C. §103(a).

The Examiner also rejected claims 16, 19, 20 and 21 under 35 U.S.C. §103(a) for the reasons set forth in the rejection of claim 4. Claims 16, 19, 20 and 21, depending from amended

claim 13 discloses substantially similar limitations as claim 4 and recites collecting execution statistics relating to the execution of the workflow on the computer system. (Amended Claim 13, emphasis added). Because InfoNet, in view of the alleged knowledge in the art, does not disclose this feature and given that claims 14, 16, and 19-22 depend from claim 13, applicants respectfully submit that claims 13, 14, 16, and 19-22 are not obvious under 35 U.S.C. §103(a) by InfoNet in view of the alleged knowledge in the art.

The Examiner has rejected claims 6-8 under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of In Concert.

In regard to the rejection of claim 6 under 35 U.S.C. §103(a), the Examiner has stated in part that:

“The method of claim 5, wherein the information is selectively displayed by positioning a pointer over the display” is disclosed, supra for claim 5, and by In Concert.

(11/29/02 Office Action, p. 11).

Applicants submit that claims 6-8 are not obvious in view of InfoNet and In Concert. Even if InfoNet and In Concert were combined, such a combination would lack one or more features of amended claim 1, from which claims 6-8 depend. Amended claim 1 recites the feature of “gathering execution statistics relating to the execution of the workflow on the computer system. (emphasis added) As discussed above, InfoNet does not disclose this feature as taught by applicants. Similarly In Concert does not gather execution statistics. For example, In Concert discusses that it keeps a detailed log of all events generated during execution of business processes. In Concert’s log of events is not gathering execution statistics, as claimed by applicants. Thus, because neither InfoNet, nor In Concert disclose applicants’ claim 1, applicants respectfully submit that claim 1 is not obvious under 35 U.S.C. § 103(a) by InfoNet in view of In Concert. Given that claims 4-8 depend from amended claim 1, applicants respectfully submit that claim 1 and 4-8 are not obvious under 35 U.S.C. § 103(a)..

The Examiner has rejected claim 9 under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of Du.

In regard to the rejection of claim 9 under 35 U.S.C. §103(a), the Examiner has stated in part that:

“A workflow system comprising: a workflow server engine for... on the display” is disclosed by InfoNet, supra for claim 1. Although InfoNet does not appear to disclose “a workflow server engine.”

(11/29/02 Office Action, p. 4).

Applicants submit that claim 9 is not obvious in view of InfoNet and Du. It is respectfully submitted that it would be impermissible hindsight, based on applicant's own disclosure, to combine InfoNet and Du.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

However, nowhere is there any indication that the references provide any motivation for the recited combination. Instead, it appears the teachings of the present application have been used as a blueprint to gather together and assemble various components of the prior art in the manner contemplated by applicants. This is a classic example of the use of hindsight reconstruction, and cannot properly be used as grounds for rejecting the present claims.

The U.S. Court of Appeals for the Federal Circuit has strongly criticized such applications of hindsight by specifically indicating that when an obviousness determination is made based upon a combination of references, even a patent examiner "must show reasons that the skilled artisan, confronted with the same problems as the inventor *and with no knowledge of the claimed invention*, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (Emphasis added). Merely indicating, as the Examiner argues in his Office Action of November 1, 2002, that the claimed invention would be obvious to one of ordinary skill in the art based on the combination of the references is utterly inadequate. *Rouffet*, at 1357. Instead, what is needed is a showing of motivation, either from the references themselves or the knowledge of those of ordinary skill in the art, for the combination being relied upon. *Rouffet*, at 1357.

In the present case, there has been no showing of such motivation. Instead, the Examiner attempts to deconstruct the subject matter of the claims of the present application into its constituent components, states where each such component may be found in one of the cited

references, and then concludes that it would have been obvious to combine the references to arrive at the claimed invention. This bare bones analysis is not sufficient to support a determination of obviousness of the present application. The burden is on the Examiner to show *why* one is so motivated as to come up with the combination being relied upon. *Rouffet*, at 1357-1358 ("If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Instead, in complex scientific fields [an infringer or the Patent Office] could routinely identify the prior art elements in an application, invoke the lofty level of skill, and rest its case for [obviousness]. To counter this potential weakness in the obviousness construct, the suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness.")

In regard to the rejection of claim 9, even if InfoNet and Du were combined, such a combination would lack one or more features of claim 9. Amended claim 9 recites the feature of an overlay data provider for providing execution statistics.... (emphasis added)

As discussed above, InfoNet does not disclose this feature as disclosed in applicants' claim 9. Nor does Du disclose "an overlay data provider for providing execution statistics...." as claimed by applicants. Du describes a system and method for performing consistent workflow process execution in a workflow management system. (Du, title) More specifically, Du describes enabling consistent workflow process execution by ensuring execution atomicity of activities of a single workflow process. (Du, col. 10, ll 44-46). This is primarily achieved by locking data while writes are performed. Consequently, Du does not teach "execution statistics", and therefore, does not teach "an overlay data provider for providing execution statistics...." Thus, because neither, InfoNet nor Du disclose applicant's claim 9, applicants respectfully submit that claim 9 and dependent claim 10 is not obvious under 35 U.S.C. §103(a) by InfoNet in view of Du.

The Examiner has rejected claim 10 under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of Du and further in view of Okita.

In regard to the rejection of claim 10 under 35 U.S.C. §103(a), the Examiner has stated in part that:

“The workflow system of claim 9, wherein the display device is a workflow editor” is disclosed, supra for claim 9. however InfoNet and Du do not appear to disclose “wherein the display device is a workflow editor”, but Okita does....

(11/29/02 Office Action, p. 13).

Applicants submit that claim 10 is not obvious in view of InfoNet, Du and Okita.

For the reasons stated above, it would be impermissible hindsight to combine InfoNet, Du and Okita. Even if InfoNet, Du, and Okita were combined, such a combination would lack one or more features of independent claim 9 from which claim 10 depends. Amended claim 9 recites the feature of an overlay data provider for providing execution statistics.... (emphasis added)

As discussed above, neither InfoNet nor Du disclose this feature as disclosed in applicants' claim 9. Nor does Okita disclose “an overlay data provider for providing execution statistics....” as claimed by applicants. Okita describes a transaction flow editing tool. (Okita, title) More specifically, Okita describes a Workflow Editor (AWE) that defines various types of transaction processes as workflows for automatic call distribution, computer telephony integration, etc... (Okita, col. 6, ll. 44-49). Okita does not teach “execution statistics” since it is not needed for its AWE, and therefore, does not teach “an overlay data provider for providing execution statistics....” Thus, because neither, InfoNet, Du nor Okita disclose applicant's claim 9, applicants respectfully submit that claim 9 and dependent claim 10 are not obvious under 35 U.S.C. §103(a) by InfoNet in view of Du and Okita.

The Examiner has rejected claim 22 under 35 U.S.C. §103(a) as being unpatentable over InfoNet in view of Borg.



In regard to the rejection of claim 22 under 35 U.S.C. §103(a), the Examiner has stated in part that:

“The method of claim 13, wherein the collected statistical information is displayed as a percentage” is disclosed by InfoNet, supra for claim 13.

(11/29/02 Office Action, p. 14).

Applicants submit that claim 22 is not obvious in view of InfoNet and Borg.

It would be impermissible hindsight to combine InfoNet and Borg. Even if InfoNet and Borg were combined, such a combination would lack one or more features of independent claim 13 from which claim 22 depends. Amended claim 13 recites the feature of collecting execution statistics relating to the execution of the workflow on the computer system... (emphasis added)

As discussed above, InfoNet does not teach this feature as disclosed in applicants' claim 13. Nor does Borg disclose “collecting execution statistics relating to the execution of the workflow on the computer system...” as claimed by applicants. Borg describes a visual schedule management system for a manufacturing facility. (Borg, title) More specifically, Borg describes a computer-based visual schedule management system that provides visual representations of the amount of work scheduled in a manufacturing facility... (Borg, abstract). Nowhere does Borg teach the use of “execution statistics” since it is not needed for its system, and therefore, Borg does not teach “collecting execution statistics relating to the execution of the workflow on the computer system...” Thus, because neither, InfoNet nor Borg disclose applicant's claim 13, applicants respectfully submit that claim 13 and dependent claim 22 are not obvious under 35 U.S.C. §103(a) by InfoNet in view of Borg.

Reconsideration of this application, as amended, is respectfully requested. The following remarks are responsive to the Office Action mailed November 29, 2002.

If there are any additional charges, please charge them to our Deposit Account No. 02-2666.

Respectfully submitted,

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